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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANURADHA NARASIMHASWAMY, DAMIAN PORCARI,
and KELLY ANNE SLANK

Appeal 2010-004716
Application 09/558,192
Technology Center 2400

Before MAHSHID D. SAADAT, ERIC S. FRAHM,
and JOHNNY A. KUMAR, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-33 and 37-41. Claims 34-36 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Introduction

Appellants' invention relates to an automated web based on-line invention disclosure system (*see* Spec. 4:1-5).

Exemplary independent claim 1 reads as follows:

1. A method of forming an online invention disclosure comprising:
 - forming an invention disclosure online by entering a plurality of selected information including a first inventor identification information from a user computer;
 - as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location;
 - prompting approval of said first inventor;
 - after approval, permanently locking the disclosure to prevent further editing of the disclosure;
 - requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket identification number for the permanently locked disclosure;
 - receiving the next available docket identification number from the docketing system; and
 - assigning the docket identification number to the permanently locked disclosure.

The Examiner's Rejections

Claims 1-33 and 37-41 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (*See* Ans. 3-4).

Claims 1-11 and 20-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemble (US 5,315,504), Dziewit (US 5,031,214), and Takano (US 6,434,580 B1). (*See* Ans. 4-19).

Claims 16-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemble, Dziewit, Applicant's Admitted Prior Art (AAPA, Spec. 2), and Takano. (*See* Ans. 19-22).

Claims 12-15, 33, 37-39, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemble, AAPA, and Takano. (*See* Ans. 23-28).

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemble, AAPA, Takano, and Dziewit. (*See* Ans. 29-30).

ANALYSIS

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner has taken the position (Ans. 3), that Appellants' disclosure lacks a written description of the step of "***requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket identification number for the permanently locked disclosure***" recited in independent claim 1. (Emphasis added). The Examiner states that, while page 11 of Appellants' Specification describes locking the document and providing the next available docket number, no support exists for "a request of a next available docket information number for the permanently locked disclosure" (*id.*).

Appellants respond by stating that "claim language need not be recited verbatim in the detailed description in order to find support under 35 U.S.C. [§] 112, first paragraph" (App. Br. 7). Appellants specifically point to their disclosure on pages 11, 14, 15, and 17-18 for the description of the claimed

subject matter (App. Br. 7). The Examiner responds by restating the rejection and further points out that the claimed disclosure system has no knowledge of the next available docket information number in order to specifically request it (Ans. 30).

The function of the written description requirement of the first paragraph of 35 U.S.C. § 112 is to ensure that the inventor has possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). In establishing a basis for a rejection under the written description requirement of the statute, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 265.

Based on a review of Appellants' Specification, we agree that Appellants' description of obtaining the docket number from the docket system after the disclosure becomes permanently locked (*see* Spec. 14:25-32) would have been recognized by one of ordinary skill in the art as requesting "a next available docket identification number for the permanently locked disclosure." We specifically find that Appellants' Specification provides a detailed description of the requesting process depicted in Figure 2 disclosing when no further changes can be made to the disclosure submission, "[t]he disclosure system makes the request and the docket system provides the next available docket number." (Spec. 11:4-12).

In view of the above discussion and considering the presented facts and the arguments made by Appellants and the Examiner, we find that

Appellants' disclosure indicates that Appellants were in possession of the claimed subject matter at the time of filing of the application. Therefore, the rejection of claims 1-33 and 37-41 under the first paragraph of 35 U.S.C. § 112 cannot be sustained.

Rejection under 35 U.S.C. § 103

Appellants contend that the Examiner erred in rejecting claim 1 as obvious over Lemble, Dziewit, and Takano because the proposed combination would not be beneficial to Lemble because Lemble already provides a way to identify a document (App. Br. 8 (citing Lemble, col. 10, ll. 7-38)). Appellants further assert that the combination of the references “would appear to unnecessarily add redundancy and complexity to the system of Lemble – without any additional functionality.” (App. Br. 8). Appellants further contend that the “reference number” discussed in columns 7 and 8 of Takano is assigned when the disclosure is initially entered, in contrast to claim 1 which requires assigning a docket number after the disclosure has been approved and locked (App. Br. 9).

In response, the Examiner identifies the relevant portions of each reference (Ans. 30-33) and properly concludes that the proposed combination would have suggested the claimed step of “requesting, . . . a next available docket identification number for the permanently locked disclosure.”¹ The Examiner has specifically provided sufficient explanation

¹ The Examiner provides supplemental discussion of how Mahoney (US 6,430,581) describes the well-known process of obtaining a next available docket number after locking the document (Ans. 33). We need not reach this supplemental reasoning as we find the Examiner's reliance on the teachings of Lemble, Dziewit, and Takano to be sufficient to support the Examiner's conclusion.

with corresponding citations to various portions of the references for teaching or suggesting each disputed feature (*id.*). Contrary to Appellants' contention that Takano enters a reference number as part of initially entering the invention disclosure into the system (App. Br. 9), we agree with the Examiner that Takano receives the client number from patent office upon completion of the final revision of the final draft (*see* Ans. 31 (citing Takano, cols. 7 and 8)).

We also agree with the Examiner's stated rationale for combining Lemble, Dziewit, and Takano (Ans. 31-32). In particular, we note that combining Takano's requesting a docket number upon completion of the disclosure and obtaining the next available number with the invention disclosure system of Lemble would have been obvious and available to the skilled artisan as a known way for distinguishing a completed application from those in various stages of processing. As stated by the Supreme Court, "the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Alternatively stated, "[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 417. Therefore, we concur with the Examiner's conclusion that the combination of Lemble, Dziewit, and Takano would have suggested to one of ordinary skill in the art all the limitations of claim 1.

CONCLUSION

On the record before us, we conclude that, because the references teach or suggest all the claim limitations, the Examiner has not erred in rejecting claim 1 as being obvious over Lemble, Dziewit, and Takano. Appellants argue the patentability of the remaining claims based on the same reasons stated for claim 1 or their dependency from their base claim (App. Br. 9-10). Therefore, we sustain the 35 U.S.C. § 103(a) rejections of claims 1-33 and 37-41 over various combinations of Lemble, Dziewit, Takano, and AAPA.

DECISION

The Examiner's decision rejecting claims 1-33 and 37-41 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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